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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/961,153	09/21/2001	Cheryl Ann Moore	6509-1068	4680

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EXAMINER

FAISON, VERONICA F

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 01/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/961,153

Applicant(s)

MOORE ET AL.

Examiner

Veronica F. Faison

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13, 16 and 20 is/are allowed.
- 6) ☒ Claim(s) 1-12, 14, 15, 17-19 and 21-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

Claims 1, 4-6, 8, 12, 13, 16, 19 and 21 have been amended, claims 20-25 have been added and no claims have been canceled. Hence, claims 1-25 are pending in the application.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-12, 14-15, 17-19, and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mansukhani (US Patent 4,243,694).

Mansukhani teaches an ink composition suitable for ink jet printing on metal, plastic or paper surfaces wherein the ink comprises a resin component (binder), at least one solvent, and a fluorescent compound (abstract and col. 1 line 63-col. 2 line 3). The reference also teaches that addition components may be present such as drying, dispersing and wetting agents (col. 2 lines 3-6). The resin/polymer component is present in the amount of 1 to 80%, which may be used alone or in blends, which dissolve in the solvents. The solvents disclosed by the reference include ethyl alcohol (ethanol), acetone, and methyl acetate, which may be used in combination as seen in the examples (col. 2 lines 24-56). The reference remains silent to the amount of solvent present, however the examples show that the solvents are present in ranges that overlap Applicant's claimed range. The resin component may be synthetic, semi-synthetic and natural resins such as polyvinyl resins include polyvinyl butyral resin (which is shown in the examples) (col. 3 lines 4+). The reference discloses a process in the claims for information recording wherein the composition is applied to a recorded information (method of printing). Mansukhani discloses that the ink was used in the ink jet printing of indicia on the ends of aluminum cans and on tin-free steel cans, wherein the indicia dried very quickly to form images. The metal surfaces may be coated (treated with a release aid) to improve the properties of the ink composition (col. 2 line 60+). However the reference does not disclose the actual time that the indicia dries, therefore it would have been obvious that the compositions would have similar drying times because they have similar ink compositions, absence evidence to the contrary. Mansukhani fails to specifically exemplify the use of methyl acetate as claimed by

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applicant. Therefore, it would have been obvious to one of ordinary skill in the art to use the methyl acetate as claimed by applicant as Mansukhani also discloses the use of methyl acetate but shows no example incorporating them.

Claims 1-7, 10-12, 17-18, and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Torii et al (US Patent 6,207,613).

Torii et al teach a reversible thermosensitive coloring composition comprising an electron donating coloring agent and an electron accepting color developer (abstract and col. 4 lines 39-41). The reference further teaches that the recording layer comprises a coloring agent, a color developer, a color formation/erasure controlling agent, a crosslinking resin (binder) and a solvent mixed. The resins disclosed by the reference include acrylic copolymers and carboxymethyl cellulose resins. The solvent that may be present in the composition includes ethanol, acetone and methyl acetate. Each component may be dispersed or dissolved in a solvent and then the dispersions and/or solutions may be mixed to prepare a coating liquid (col. 21 lines 19-62). The reference broadly discloses a process of making an ink composition, wherein the Applicant has a detailed process of making, however in general, the transposition of process steps or the splitting of one step into two, where the processes are substantially identical or equivalent in terms of function, manner and result, was held to be not patentably distinguish the processes. *Ex parte Rubin* 128 USPQ 440 (PTO BdPatApp 1959). The reference shows in the examples that the solvent may be used in combination. The undercoat layer, recording layer, intermediate layer, and protective layer may include a lubricant (release aid). The recording material may be any shape

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such as a sheet, card, roll, and may have a print layer thereon which may be formed by ink jet printing (col. 25 lines 6-12). Torii et al fail to specifically exemplify the use of methyl acetate as claimed by applicant. Therefore, it would have been obvious to one of ordinary skill in the art to use the methyl acetate as claimed by applicant as Torii et al also discloses the use of methyl acetate but shows no example incorporating them.

### ***Allowable Subject Matter***

Claim 13, 16 and 20 are allowed.

The following is a statement of reasons for allowance: The references alone or in combination fail to teach the ink composition comprising a colorant, binder and a solvent which comprises methyl acetate printed onto a substrate which is based on a polymer selected from the group consisting of polymers of propylene, polymers of ethylene and polymers of propylene and ethylene or wherein the substrate is formed into a wrapping for a food product.

### ***Response to Arguments***

Applicant's arguments filed October 17, 2003 have been fully considered but they are not persuasive.

Applicant argues that both references do not teach methyl acetate in an amount to achieve an ink suitable for ink jet printing. The Examiner would like to point out that an ink suitable for use in an ink jet printing has not been given any patentable weight,

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because intended use of composition is not patentably significant. *In re Albertson* 141 USPQ 730 (CCPA1964); *In re Heck* 114 USPQ 161 (CCPA 1957).

Applicant also argues that the references do not teach a drying time of less than one second. The Examiner would like to point out that this limitation not required for the independent claims and that Applicant has not shown that the addition of methyl acetate would not result in a similar ink with the same properties of the claimed invention.

Therefore the rejections have been maintained.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

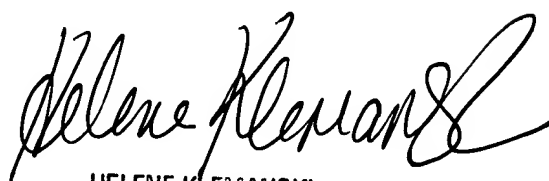
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Veronica F. Faison whose telephone number is 571-

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272-1366. The examiner can normally be reached on Monday-Thursday and alternate Fridays 8 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on 571-272-1362. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Veronica F. Faison

A handwritten signature in black ink, appearing to read 'Helene Klemanski', with a stylized flourish at the end.

HELENE KLEMANSKI  
PRIMARY EXAMINER  
GROUP 1100